

REMARKS/ARGUMENTS

Claim 1 has been amended to incorporate claim 2. In addition, claim 1 has been amended to further clarify the subject matter regarded as the invention. Other independent claims have been amended in a similar manner.

In the Office Action, the Examiner has rejected claims 1-48 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,393,057 (*Marnell, II*). The Examiner's rejection of claims is fully traversed below.

In the Office Action, the Examiner has asserted that *Marnell, II* inherently teaches subtracting a progressive jackpot wager amount from a player's available credit if the player's wager is greater than or equal to a minimum wager amount (Office Action, page 3). In order to support this assertion, the Examiner has alleged that "otherwise, *Marnell, II* would not operate as intended." Contrary to the Examiner's assertion, it is respectfully submitted that the secondary game of *Marnell, II* need not be a progressive game. It is clear that *Marnell, II* teaches:

An electronic gaming apparatus (21) including an electronic primary gaming device (22), such as a poker gaming device or slot machine and an electronic secondary gaming device (23). The electronic poker gaming device (22) is electrically coupled to the electronic secondary gaming device (23), and the primary gaming device (22) is responsive to the occurrence of selected events, such as poker hands or slot machine reel combinations, for input into the secondary gaming device (23). Thus, the occurrence of poker hands in the poker gaming device (22) produces selection of a space (52) in the bingo matrix (51) of a bingo-type gaming device (23). A plurality of poker gaming devices or slot machines (21.sub.1 -21.sub.16) can be electrically coupled to a common bingo gaming device (23) for simultaneous play of a single bingo game by a plurality of players, each of whom is playing his or her own individual poker game. [*Marnell, II*, Abstract]

It is evident that the secondary game (bingo game) of *Marnell, II* does not have to be a progressive game. It should also be noted that there is no evidence to support the Examiner's contention that *Marnell, II*'s methodology can only work if an amount is subtracted for the second game when the player's wager is greater than or equal to a minimum wager amount.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly

inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was . It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

Clearly, the Examiner has not provided support to show that the pertinent claimed features necessarily flow from the teaching of *Marnell, II*. Accordingly, it is respectfully submitted that the Examiner's rejection is improper and should be withdrawn.

Moreover, it is respectfully submitted that *Marnell, II* does not teach or suggest providing a secondary game as a progressive game, wherein a progressive jackpot wager is subtracted in response to receiving input for the player's wager on a primary game.

It is noted that *Marnell, II* states that:

As also is known, electronic poker gaming apparatus can be coupled together with a plurality of machines in a common carousel so that a plurality of players can try to win a progressive jackpot. As seen in FIG. 5, therefore, poker machines 21.sub.1 -21.sub.16 are coupled together at a carousel, generally designated 40, to permit a progressive jackpot to be incremented as a function of, or in proportion to, the coin-in to the machines 21.sub.1 -21.sub.16. As seen in FIG. 1, therefore, a display window 48 shows the current value 49 of a progressive jackpot. Again, this is conventional electronic poker gaming apparatus technology and does not, per se, form a novel portion of the gaming apparatus of the present invention. [Col. 4, line 63 - Col. 5, line 7, of *Marnell, II*]

However, it is respectfully submitted that this conventional approach does not teach or suggest providing a second progressive game which is awarded based on the outcome of a primary game that is different than the second game.

It should further be noted that *Marnell, II* teaches:

If the player is able to "draw" a poker hand meeting the poker game criteria for a winning hand, the occurrence of such a winning hand either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also includes the winning hand. [Col. 5, lines 63-68, of *Marnell, II*]

As such, *Marnell, II* teaches that the poker game (primary game) and the bingo game (secondary game) are effectively connected only when the outcome of the poker game is a winning hand. In contrast, the claimed invention does not require the outcome of the wagering game (primary game) to be a winning outcome in order to effectively connect the wagering game to the progressive jackpot for the secondary game. As such, the methodology of the claimed invention differs from *Marnell, II* in yet another significant respect.

Accordingly, it is respectfully submitted that the independent claims are patentable over *Marnell, II* for at least these reasons.

It is further submitted that the dependent claims recite additional features that render them patentable for additional reasons. For example, claim 3 recites: "wherein the outcome of the occurrence of the wagering game is a predetermined progressive jackpot winning outcome if the player matches the predetermined progressive jackpot winning outcome within a predetermined maximum number of sequentially selected game indicia." It is respectfully requested that the Examiner withdraw the rejection or provide a specific reference in *Marnell, II* that properly addresses this claimed feature.

Based on the foregoing, it is submitted that the claims are patentably distinct over the cited art of record. Additional limitations recited in the independent claims or the dependent claims are not further discussed because the limitations discussed above are sufficient to distinguish the claimed invention from the cited art. Accordingly, Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner.

Applicant hereby petitions for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 500388 (Order No. IGT1P208F). Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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